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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,612	06/26/2003	Hideo Arai	500.30304C14	3383

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EXAMINER

DINH, TAN X

ART UNIT PAPER NUMBER

2653

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/603,612

Applicant(s)

ARAI ET AL.

Examiner

TAN X. DINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 is/are allowed.
- 6) ☒ Claim(s) 11-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 07/727,059.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

1) The Continuation Data is acknowledged. This application is a Continuation of S/N 10/404,452, filed on 4/02/2003; which is a Continuation of S/N 09/809,047, filed on 3/16/2001 and now is US 6,498,691; which is a Continuation of S/N 09/654,962, filed on 9/05/2000 and now is US 6,324,025; which is a Continuation of S/N 09/567,005, filed 05/09/2000 and now is US 6,278,564; which is a Continuation of S/N 09/326,595, filed 06/03/1999, and now is US 6,069,757; which is a Continuation of S/N 09/188,303 filed 11/10/1998 and now is US 6,002,536; which is a Continuation of S/N 08/917,176 filed 08/25/1997, and now is US 5,862,004; which is a Continuation of S/N 08/620,879, filed 03/22/1996, and now is US 5,699,203; which is a Continuation of S/N 08/457,597, filed 06/01/1995, and now is US 5,530,598; which is a Continuation of S/N 08/457,486, filed 06/01/1995, and now is US 5,517,368; which is a Continuation of S/N 08/238,528, filed 05/05/1994, and now is US 5,671,095; which is a Divisional Application of S/N 07/727,059, filed 07/08/1991, and now is US 5,337,199.

Further, the application S/N 10/734,302, filed on 12/15/2003 is a Continuation of this instant application.

2) The I.D.S filed 6/26/2003 and 7/02/2004 have been considered by the Examiner. However, the Japan and/or foreign document(s), if they have not been written in English, are considered to the

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extent that could be understood from the English Abstract and the drawings.

Form PTO-1449 or PTO/SB/08 is(are) attached herein.

3) Claims *11-14* are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "the second compression system" (claim 11, line 19) lacks clear antecedent basis. No "second compression system" has been previously recited in the claim and therefore the limitation cannot be understood.

Claim(s) 12-14 incorporate the indefiniteness of claim(s) 11 by virtue of their dependency thereon.

4) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970) and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed Terminal Disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5) Claims *11-14* are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims *1-4* of copending Application No. 10/404,452. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

The different between the claims of these application is that the instant application using a first compression system for compressing video bit information and the other application is used a discrete cosine transform for compressing video bit information. However, discrete cosine conversion system or any other compression systems for compressing video signal is old and widely used in the art for compressed the video signal ( after compressing video signal the transmission rate could reduced to, for example, one twentieth ). Therefore, to use discrete cosine conversion or any available compressing system for compressing

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video signal as claimed is deemed obvious to someone within the level of skill in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6) Claims 1-10 are allowed.

7) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure ( See form PTO-892 attached herein ).

Applicant is reminded that in amending in response to a rejection of claims ( if the rejection involves with any applicable arts ), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR §1.111(c).

8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN X. DINH whose telephone number is (703) 308-4859. The examiner can normally be reached on Monday - Friday, 8:00AM - 5:30PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



TAN DINH  
PRIMARY EXAMINER

November 12, 2004